



#8  
Patent  
Attorney's Docket No. 032927-012  
J.J.  
7-6-03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Anders ONSHAGE et al.

Application No.: 09/903,717

Filed: July 13, 2001

For: A METHOD OF RECORDING  
INFORMATION EXCHANGED  
BETWEEN  
TELECOMMUNICATIONS  
DEVICES, A METHOD OF  
PROHIBITING SUCH ...

) MAIL STOP AF  
)  
)  
)  
)  
)  
)  
)  
)  
)  
)  
)  
)  
)  
)  
)

RECEIVED

JUL 03 2003

Technology Center 2600

**PETITION TO WITHDRAW FINALITY**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicants respectfully submit that the final Office Action issued on March 28, 2003, in connection with the above-identified application is premature.

Accordingly, Applicants request that the finality of this Office Action be withdrawn.

MPEP §706.07(a) states that "a second or any subsequent action on the merits shall be final, except where the Examiner introduces a new grounds of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 C.F.R.

§1.97(c)." It is respectfully submitted that the Office Action includes a new grounds of rejection that was not necessitated by an amendment nor based upon information contained in an IDS filed during the period set forth in 37 C.F.R. §1.97(c). In the Office Action

issued on October 24, 2002, Applicants' claims 1, 2, 4, 6-8, 10, 11 and 13-16 were rejected as allegedly being anticipated by U.S. Patent No. 6,434,143 to Donovan ("Donovan"). In response to this rejection, in Applicants' Amendment filed on January 24, 2003, Applicants' dependent claim 4 was amended into independent form by incorporating the elements of claim 1, the only claim from which it depended, into claim 4. In the Office Action issued on March 28, 2003, Applicants' claims 1-16 were rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent No. 6,529,602 to Walker et al ("Walker"). In the conclusion section of this Office Action, it is asserted that Applicants' amendment necessitated this new grounds of rejection, and hence, this Office Action was made final.

As discussed above, in response to the Office Action's rejection of Applicants' claim 4, which depended directly from claim 1, Applicants amended claim 4 into independent form by including the elements of claim 1. Since the combination of claims 1 and 4 was asserted to be anticipated by Donovan, and since claim 4 was amended to include the elements of claim 1, Applicants' amendment to claim 4 could not have necessitated the new grounds of rejection of Applicants' claim 4. In other words, Applicants' amended claim 4 was no different than the claim 4 rejected by Donovan since claim 4 included all of the elements of claim 1 from which it depended.

Since the Office Action issued on March 28, 2003 applied a new grounds of rejection against Applicants' claim 4, which was no different from claim 4 rejected in the previous Office Action, it is respectfully submitted that it was the deficiencies of Donovan which necessitated a new grounds of rejection against Applicants' claim 4, and not

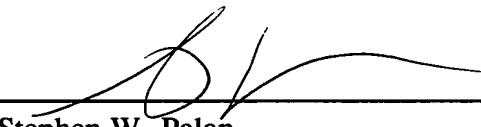
Application No. 09/903,717  
Attorney's Docket No. 032927-012  
Page 3

Applicants' amendment to claim 4. Additionally, Walker was not cited in the IDS during the period set forth in 37 C.F.R. 1.97(c).

For at least those reasons stated above, it is respectfully submitted that the Office Action issued on March 28, 2003 was made final improperly, and hence, withdrawal of the finality of this Office Action is respectfully requested.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By:   
Stephen W. Palan  
Registration No. 43,420

P.O. Box 1404  
Alexandria, Virginia 22313-1404  
(703) 836-6620

Date: June 30, 2003